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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/077,669 | 02/15/2002 | Yann Limelette | 76.0715 | 3000 |

7590 09/02/2003

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EXAMINER

WALSH, DANIEL I

ART UNIT PAPER NUMBER

2876

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

10/077,669

Applicant(s)

LIMELETTE ET AL.

Examiner

Daniel I Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 10 July 2003.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Smith, III (US 5,700,036).

Smith teaches a wrapped card assembly comprising a data encoded card enclosed in a wrapping of a single material, the data encoded card comprising confidential and non-confidential information in a visible form, wherein the wrapping is made of a single material, the wrapping comprising an opaque area which covers at least partially the confidential information; and a transparent area which covers at least partially the non-confidential information through FIG. 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3 Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, III in view of Fehrman et al. (US 6,193,163).

The teachings of Smith, III has been discussed above.

Smith, III teaches the card that is being covered can be of the type of a license, identification card, credit card, etc. (col 2, lines 48+), but Smith, III is silent to the card having a detachable integrated circuit module detachable from the main body.

Fehrman et al. teaches an integrated circuit module that is detachable from the main body (see FIG. 1). Further, chip cards are well known to include graphics/indicia/non-confidential information on the front, and confidential information on the rear, as seen by the American Express Blue card, chip based phone cards, or metro smart cards where graphics (non-confidential) are printed on the front, but on the rear confidential information (numerical card number information) is printed, for example.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Smith, III with those of Fehrman, in order to have a way to protect credit cards, licenses, identification cards, data encoded cards, etc. that include chip cards, since such detachable chip cards are well known and conventional, and would derive beneficial and obvious results from having such a protective cover, as is conventional in the art.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, III, as applied to claim 1, above, in view of Hansen et al. (US 6,315,206).

The teachings of Smith, III have been discussed above.

Smith, III teaches that the opaque area covers confidential information on the card, and that the opaque area can be located in various locations depending on the layout of the confidential information of the card (col 6, lines 11+). However, Smith, III is silent to the confidential data specifically being a PIN and personal unblocking key.

Hansen et al. teaches that the confidential information printed on the rear include a PIN, but fails to teach it includes a personal unblocking key. However, it is well known in the art and conventional, to print information on cards for enhancing identification, security, etc., as seen with credit card, debit cards, smart cards, phone cards, etc, where an account number, or PIN, or unique identifier is printed. Further, PUK (personal unblocking keys) are well known and conventional in the art for unblocking cards that have been blocked for security reasons, (see Uusitalo US 6,366,77; col 3, lines 40+, which teaches the use of a PIN and PUK with a card). Therefore, simply printing additional (confidential) information on the card (PUK) that is well known and conventional in the art as a security measure to ensure authorized access, is well within the ordinary skill in the art, and therefore obvious, especially in light of

printing PINs to permit usage of the card, motivated by providing more security related information to the card holder (i.e. PIN/PUK, etc.) to permit usage of the card.

Therefore, at the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Smith, III with those of Hansen et al.

One would have been motivated to do this to cover well known/conventional confidential information in a means that is accepted and obvious in the art.

5. Claims 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, III.

Re claims 4-5, Smith, III teaches a card with confidential and non-confidential information in visible form where the card is enclosed in a wrapping made of a single material, the wrapping comprising an opaque area and a transparent area so that the opaque area covers at least partially the confidential area and so the transparent area covers at least partially the non-confidential information (see FIG. 5). It is well known and obvious that such a card is made by a personalization step where the card is provided with information, as is conventional in the art. Further, it is well known and obvious that the personalization step can be immediately followed by the wrapping step, as in such instances when a user issues a drivers license or identification, and immediately places the a card in the wrapping/cover to protect it and its confidential and non-confidential information.

Re claims 6-9, Smith , III teaches that the wrapping is made of a polypropylene film (col 4, lines 15+) (re claim 7), and that the opaque area comprises an opaque ink (col 5, lines 50+) (re claim 9). Though Smith, III is silent to the wrapping being made of a cellophane (re claim 6) or polystyrene film (re claim 8), it is well known and conventional that such materials are suitable for card covering purposes, and therefore would be obvious expedients (See Main (US

6,027,597, re cellophane usage and Matheis et al. re polystyrene usage). Though Smith, III is silent to the use of metallic inks (re claim 10), metallic inks are well known and obvious in the art for providing a metallic/shiny and aesthetically pleasing effect, while also having the ability to trip sensors/detectors by its metallic properties in various systems. Therefore, it would have been obvious to use inks of a metallic nature as a matter of design variation, as well known means to improve among other things, the aesthetic appearance of cards/covers and therefore is an obvious design variation. Further, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use such alternative materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Response to Arguments

6. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

7. In response to the Applicants' amendment of the claims, the Examiner has cited the new art of Smith, III. Accordingly, the action is FINAL, as necessitated by the Applicants' amendments.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Main (US 6,027,597), Bauman (US 5,184,658), Keller (US 5,700,037), and Kamens et al. (US 5,941,375).

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel Walsh** whose telephone number is **(703) 305-1001**. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [daniel.walsh@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



DW
8/12/03



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